

REMARKS

The Office Action dated November 15, 2006 has been received and carefully noted. Claims 1- 29 were examined. Claims 10, 11 and 12 were objected to because of informalities. Claims 1-4, 7, 23-26 and 29 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-3, 7-9, 11, 12, 15 and 19-21 were also rejected under 35 U.S.C. § 102(a) and claims 4-6, 10, 13, 14, 16-18 and 22-29 were also rejected under 35 U.S.C. § 103(a).

Claims 10-12 have also been amended to correct the informalities as suggested by Examiner. Claims 1, 8, 16, 19 and 23 have also been amended. Claims 2, 9 and 20 have been cancelled. New claim 30 has been added. Entry is requested. Support for these amendments and additions can be found in the specification. No new matter has been added or the scope expanded. Claims 1-30 remain pending in the application.

Reconsideration of the pending claims is respectfully requested in view of the amendments and the following remarks.

I. Claim Objections

Examiner objected to claims 10, 11 and 12 due to typographical errors. Applicant has modified these claims as suggested by Examiner.

Applicant respectfully request that the objection to claims 10, 11 and 12 be withdrawn.

II. Claims Rejected Under 35 U.S.C. § 101

In the outstanding action, Examiner rejects claims 1-4, 7, 23-26 and 29 under 35 U.S.C. § 101 alleging that the claims “merely recites manipulation of a signal and...merely recites the program performing certain steps” (*Office Action, Page 2-3*). Applicant respectfully submits that the claims do provide a useful, tangible result and thus is in compliance with 35 U. S. C. §101.

Specifically, Examiner rejects claims 1-4 and 7 as mere manipulation of a signal. MPEP §2106 (IV)(C)(2) states that “a claimed invention is directed to a practical application of a 35 U.S.C. § 101 judicial exception when it: (a) ‘transforms’ an article or physical object to a different state or thing; or (a) otherwise produces a useful, concrete and tangible result.” Thus, determining if the claim transforms a physical object is the first step in the analysis. If it is determined that the claim does not entail the transformation of an article, then the claims should be reviewed to determine if it produces a “useful, tangible, and concrete” result.

MPEP § 2106 (II)(A) also lists examples of claimed inventions that have a practical application because they produce a useful, concrete, and tangible result. Examples such as “a long-distance telephone billing process containing mathematical algorithms” disclosed in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999), and “[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price” in *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601, are patentable subject matter because they have practical value and produce useful, concrete and tangible result.

Here, claims 1-4 and 7 are methods that act on digital data stream that is received at the video decoder. The data streams that are received by video decoders are video signals and not some abstract entity. Video signals are electrical entity that has practical real world applications. As in *State Street* and *AT&T*, these claimed methods operate on discrete data streams and result in distribution of video contents and thus produce an useful and concrete result that has a tangible effect. Therefore, the claims yield a useful, concrete, and tangible result and accordingly, under *AT&T Corp.* and *State Street*, these claims are directed to a statutory subject matter.

Examiner rejects claims 23-26 and 29 as merely reciting the program performing certain steps. The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (“*Guidelines*”) provides the criterion for examining computer programs for statutory material for patentability. The *Guidelines* states “[o]nly when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory” (*Page 53, 2nd paragraph*). The *Guidelines* continues and states that the computer program can be just a set of instructions capable of being executed by a computer and be a nonstatutory functional descriptive material unless its functionality can be realized by use of computer-readable medium and are statutory subject matter and complies with 35 U.S.C § 101.

In claims 23-26 and 29, the claims are clearly directed to a computer media which contains instructions that when executed causes a digital processing system to act on digital data stream which is received by a video decoder. As discussed above, the effect of executing these instructions is that there is a useful, concrete and tangible real world result. Thus, the functionality of these instructions can be realized because of executing instructions from a

computer readable media. Therefore, claims 23-26 and 29 are directed toward the statutory subject matter.

Based on case law and *MPEP*, these claims are directed to patentable subject matter under 35 U.S.C. § 101. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-4, 7, 23-26 and 29 under 35 U.S.C. § 101.

III. Claims Rejected Under 35 U.S.C. § 102

Claims 1, 3, 7, 8, 11, 12, 15, 19 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0126752 by Kim (hereinafter "*Kim*"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *MPEP* § 2131. Applicant respectfully submits that each and every element in independent claims 1, 8 and 19 as amended is not set forth in the cited reference.

With regard to independent claims 1, 8 and 19, these amended claims include the limitation that the aggressiveness of down sampling of the decoded data stream is dynamically adjustable. *Kim* discloses a video transcoding apparatus that down samples a video bit stream before storing the down sampled macro block. (*Page 3, paragraph [0047]*) It does not disclose that the down sampling of the data stream is dynamically adjusted. Thus, *Kim* does not teach or suggest the element of dynamical adjustment of the aggressiveness of down sampling. Accordingly, Applicant respectfully submits that independent claims 1, 8 and 19 are not anticipated by *Kim*.

With regard to claims 3, 7, 11, 12, 15 and 21, these claims depend from their independent claims 1, 8 and 19, respectively and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims, *Kim* does not teach each of the elements of these claims. Accordingly, Applicant respectfully submits that independent claims 1, 8 and 19 and their dependent claims are not anticipated by *Kim* and respectfully requests withdrawal of rejection under 35 U.S.C. § 102(a).

IV. Claims Rejected Under 35 U.S.C. § 103

a) Claims 4-6, 10, 13, 14, 16-18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of U.S. Publication No. 2003/0041257 by Wee et al. (hereinafter "*Wee*"). To establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference; (2) there must be a reasonable expectation of success; and (3) the references when combined must teach or suggest all of the claim limitations. *MPEP* § 2142. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

With regard to amended independent claim 16, it includes the limitation that the aggressiveness of down sampling of the decoded data stream is dynamically adjustable. As discussed above, *Kim* does not teach or suggest such an element. *Wee* does not cure this defect. Paragraph 3 lines 1-4, 10-11 and Paragraph 4 of *Wee* which the Examiner cites as disclosing down sampling discloses only scalability and efficiency needed in the wireless streaming environment (*Office Action, Page 6, lines 3-4 from bottom*). It does not discuss any down sampling. Examiner does not indicate and Applicant has been unable to discern any other sections of *Wee* that teach or suggest that the aggressiveness of down sampling of the decoded data stream is dynamically adjustable. Therefore, the cited references do not singularly or in combination, teach or suggest each of the elements of claim 16. Applicant respectfully request the withdrawal of the rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Wee*.

With regard to claims 4-6, 10, 13, 14, 17, 18 and 22, these claims depend from their independent claims 1, 8, 16 and 19, respectively and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claims 1, 8, 16 and 19, *Kim* does not teach each of the elements of these claims. *Wee* does not cure this defect of not having the element of aggressiveness of down sampling of the decoded data stream being dynamically adjustable.

Therefore, the cited references do not singularly or in combination, teach or suggest the elements of these claims. Applicant respectfully request the withdrawal of the rejection of claims 4-6, 10, 13, 14, 16-18 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Wee*.

b) Claims 23, 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of U.S. Patent No. 6,052,415 issued to Carr et al. (hereinafter "*Carr*"). Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

With regard to amended independent claim 23, it includes the limitation that the aggressiveness of down sampling of the decoded data stream is dynamically adjustable. As discussed above, *Kim* does not teach or suggest such an element. *Carr* does not cure this defect.

Examiner does not indicate and Applicant has been unable to discern any other sections of *Carr* that teach or suggest that the aggressiveness of down sampling of the decoded data stream being dynamically adjustable. Therefore, the cited references do not singularly or in combination, teach or suggest each of the elements of claim 23. Applicant respectfully request the withdrawal of the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Wee*.

With regard to claims 24, 25 and 29, these claims depend from their independent claim 23 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 23, *Kim* does not teach each of the elements of these claims. *Carr* does not cure this defect of not having the element of aggressiveness of down sampling of the decoded data stream is dynamically adjustable.

Therefore, the cited references do not singularly or in combination, teach or suggest the elements of these claims. Applicant respectfully request the withdrawal of the rejection of claims 23, 25 and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Carr*.

c) Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Carr* and in further view of *Wee*. Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

With regard to claims 26-28, these claims depend from their independent claim 23 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 23, *Kim* does not teach each of the elements of these claims. *Carr* does not cure this defect of not having the element of aggressiveness of down sampling of the decoded data stream is dynamically adjustable. As discussed above, *Wee* does not cure this defect either.

Therefore, the cited references do not singularly or in combination, teach or suggest the elements of these claims. Applicant respectfully request the withdrawal of the rejection of claims 26-28 under 35 U.S.C. § 103(a) as being unpatentable over *Kim* in view of *Carr* and in further view of *Wee*.


CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-30, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: _____, 2007

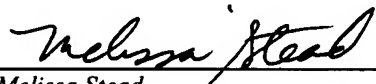


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Date